

Remarks

I. Status of claims

Claims 1-30 are pending.

II. Claim objections

None of the amended claims recites "the at least". Accordingly, the objection to the claims should be withdrawn.

III. Claim rejection under 35 U.S.C. § 112

The Examiner has rejected claim 6 under 35 U.S.C. § 112, second paragraph, for "insufficient antecedent basis."

Claim 6, which depends from claim 1, has been amended and now recites "the label composer is operable to designate the representative image before any of the images in the collection are stored in the memory of the portable data storage device received in the port." Each of the elements recited in claim 6 (i.e., "the label composer", "the representative image", "the images in the collection", "the memory", "the portable data storage device", and "the port") has antecedent support in claim 1.¹

For at least this reason, the rejection of claim 6 under 35 U.S.C. § 112, second paragraph, should be withdrawn.

IV. Claim rejections under 35 U.S.C. § 102

The Examiner has rejected claims 1-30 under 35 U.S.C. § 102(e) over Niikawa (U.S. 6,992,672).

¹ Regarding the use of the word "before", the Examiner's attention is drawn to page 5, lines 12-19, of the specification, which explains that: "The expression "being stored" refers to image data that currently is stored in the portable data storage device memory or is slated to be stored in the portable data storage device memory. Thus, the representative image may be selected before or after the representative image is stored in the portable data storage device memory. For example, in some implementations, the image data in a collection to be stored and at least one representative image first are selected and then stored in a portable data storage device."

A. Applicable standards for sustaining a rejection under 35 U.S.C. § 102(e)

The relevant part of 35 U.S.C. § 102(e) states that a person shall be entitled to an invention, unless - “the invention was described in -- (1) an application for patent published under section 122(b), by another filed in the United States before the invention by the applicant for patent...” Anticipation under 35 U.S.C. § 102(e) requires that each and every element of the claimed invention be present, either expressly or inherently, in a single prior art reference. EMI Group N. Am., Inc., v. Cypress Semiconductor Corp., 268 F.3d 1342, 1350 (Fed. Cir. 2001). Anticipation must be proved by clear and convincing evidence. Electro Medical Systems, S.A. v. Cooper Life Sciences, Inc., 34 F3d 1048, 1052 (Fed. Cir. 1994).

B. Independent claim 1

Independent claim 1 has been amended and now recites:

1. An image processing apparatus, comprising:
 - a port configured to receive a portable data storage device having a memory configured to store a collection of image data and a digital label including a plurality of display elements each capable of presenting one of at least two possible colors;
 - a label composer operable to designate an image in a collection of images being stored in the memory of a portable data storage device received in the port as a representative image that represents the images in the collection; and
 - a print module coupled to the port and the label composer and operable to selectively configure the display elements in the digital label of the portable data storage device received in the port to print an image corresponding to the representative image designated by the label composer.

As explained in detail below, the rejection of independent claim 1 under 35 U.S.C. § 102(e) over Niikawa should be withdrawn because Niikawa neither expressly nor inherently discloses each and every element of the invention defined by the claim. In particular, Niikawa neither expressly nor inherently discloses “a label composer operable to designate an image in a collection of images being stored in the memory of a portable data storage device received in the port as a representative image that represents the images in the collection.”

In accordance with Niikawa's disclosure, thumbnail images of all of the images stored on a memory card are displayed on the LCD 10. For example, in col. 15, lines 51-63, Niikawa explains that (emphasis added):

...After completion of the format process, a framework 80 for thumbnail images, the number of photographed frames 82 and the remaining capacity of the card 83 are displayed on the liquid crystal display 10. A thumbnail image of one frame is of a size of 80×60 pixels, and a space for display of information must be set in the periphery. Accordingly, thumbnail images of 16 frames can be displayed. Further, depending on the image size of the digital camera and the capacity of the memory card, more than 16 photographs can be taken. In this case, thumbnail images of all the frames are displayed by reducing the size of each image, or only thumbnail images of the latest used 16 frames are displayed.

Similarly, in the Summary of the Invention section of his disclosure, Niikawa explains that (col. 2, lines 23-26; emphasis added):

...When the storage medium is ejected from the receiving section, the display section exactly indicates the content of the memory section. Therefore, even if the user has a plurality of storage media, the user [will] never be confused.

With reference to FIG. 23, Niikawa additionally explains that the thumbnail images of the images stored on the memory card are display in order of frame number (col. 16, lines 25-41; emphasis):

...as FIG. 23 shows, thumbnail images 85 and frame numbers 81 of photographed images are displayed in the respective display sections for the frames. Simultaneously, the number of used frames 82 and the remaining capacity 83 of the memory card 56 are renewed. Then, other processes in the photography mode are carried out at step S 25, and the program goes to step S 33 .

In the liquid crystal display 10, as described above, the data electrode driving circuit 22 drives the data electrodes which extend in the column direction, and therefore, data are written row by row. Accordingly, addition of a thumbnail image is made in the column direction as shown by arrow "Y" in FIG. 23. If a thumbnail image is added in the row direction (perpendicular to the direction of

arrow "Y"), for example, when a thumbnail image of the second frame is to be added, the thumbnail image of the first frame must be written again, which requires more time for renewal.

Thus, Niikawa neither expressly nor inherently discloses "a label composer operable to designate an image in a collection of images being stored in the memory of a portable data storage device received in the port as a representative image that represents the images in the collection." Instead, Niikawa expressly discloses that each of the images that is stored on the memory card is represented by its respective thumbnail image.

For at least this reason, the rejection of independent claim 1 under 35 U.S.C. § 102(e) over Niikawa now should be withdrawn.

Regarding the label composer element of claim 1, the Examiner has stated that:

...Niikawa discloses the digital camera, which reads on claimed label composer; having a user interface that allows a user to select an image from a group of images stored in memory, which reads on claimed operable to select at least one image in a collection of image data being stored in the memory of a portable data storage device received in the port as representative of the image data collection; as disclosed at column 15, lines 6-9 and column 20, lines 39-44. ...

Niikawa's disclosure in col. 16, lines 6-9, however, describes how images are displayed in the LCD section 110 of the camera itself, not the LCD 10 on the memory card (see, e.g., FIG. 15, and col. 11, lines 23-27).

In col. 20, lines 38-44, Niikawa describes aspects of a camera 100' in which the LCD section 110 is either turned off or not present (see, e.g., col. 17, line 39 - col. 18, line 6) and the LCD 10 of the memory card 56 is used as a display section of the camera 100' (see col. 18, lines 7-9, and FIGS. 25 and 26). In particular, this disclosure describes a "reproduction" mode of operating the camera 100' in which one of the images stored on the memory card 56 is displayed on the LCD 10 at a time. In this mode of operation, the camera 100' does not "designate an image in a collection of images being stored in the memory of a portable data storage device received in the port as a representative image that represents the images in the collection," as recited in claim 1. Instead, in response to a frame change request in the form of a signal from the

button 121 (see FIG. 25), the camera 100' displays a preceding or successive one of the image frames stored on the memory card 56 in the LCD 10. In this process, the displayed image is not designated as a representative image that represents any of the other image frames stored on the memory card 56.

C. Dependent claims 2-8

Each of claims 2-8 incorporates the elements of independent claim 1 and therefore is patentable over Niikawa for at least the same reasons explained above.

D. Independent claim 9

Independent claim 9 has been amended and now recites elements that essentially track the pertinent elements of independent claim 1 discussed above. Therefore, independent claim 9 is patentable over Niikawa for at least the same reasons explained above in connection with independent claim 1.

E. Dependent claims 10-13

Each of claims 10-13 incorporates the elements of independent claim 9 and therefore is patentable over Niikawa for at least the same reasons explained above.

F. Independent claim 14

Independent claim 14 has been amended and now recites elements that essentially track the pertinent elements of independent claim 1 discussed above. Therefore, independent claim 14 is patentable over Niikawa for at least the same reasons explained above in connection with independent claim 1.

G. Dependent claims 15 and 16

Each of claims 15 and 16 incorporates the elements of independent claim 14 and therefore is patentable over Niikawa for at least the same reasons explained above.

H. Independent claim 17

Independent claim 17 has been amended and now recites elements that essentially track the pertinent elements of independent claim 1 discussed above. Therefore, independent claim 17 is patentable over Niikawa for at least the same reasons explained above in connection with independent claim 1.

I. Dependent claims 18 and 19

Each of claims 18 and 19 incorporates the elements of independent claim 17 and therefore is patentable over Niikawa for at least the same reasons explained above.

J. Independent claim 20

Independent claim 20 has been amended and now recites elements that essentially track the pertinent elements of independent claim 1 discussed above. Therefore, independent claim 20 is patentable over Niikawa for at least the same reasons explained above in connection with independent claim 1.

K. Dependent claims 21-30

Each of claims 21-30 incorporates the elements of independent claim 20 and therefore is patentable over Niikawa for at least the same reasons explained above.

V. Conclusion

For the reasons explained above, all of the pending claims are now in condition for allowance and should be allowed.

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